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OFFICE OF PETITIONS

In re Patent No. 6,767,370
Rolf Espe
Issue Date: May 18, 2004
Application No. 09/810,283
Filed: March 16, 2001
Attorney Docket No. 3985

: LETTER REGARDING
: PATENT TERM ADJUSTMENT
: and
: NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION
:

This is in response to the "REQUEST FOR REVIEW OF PTA DETERMINATION," filed June 21, 2004, pursuant to patentee's duty of candor and good faith to the Office. Patentee states that the Patent Term Adjustment of 18 days shown in the above-identified patent may be incorrect.

The request for reconsideration of the patent term adjustment indicated in the patent is granted to the extent indicated herein.

Patentee is given **TWO (2) MONTHS** from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

On May 18, 2004, the application matured into U.S. Patent No. 6,737,370, with a revised patent term adjustment of 18 days. On June 21, 2004 (certificate of mailing June 17, 2004), patentee submitted this request for reconsideration of patent term adjustment. Patentee discloses that no PTO delay should have arisen from the final Office action until the notice of allowance in view of the intervening Advisory Action which may have triggered a reduction. In addition, patent requests reconsideration of the reductions of 27 and 58 days for the filing of an Information Disclosure Statement on March 31, 2003 and a Statement of Substance of Interview on December 10, 2003. Patentee does not submit the required fee under § 1.18(e) for reconsideration of PTA.

**Patentee's disclosure pursuant to
their duty of candor and good faith**

In regards to the period of adjustment of 4 days associated with the Office's mailing of the notice of allowance, patentee advises

the Office of an error in their favor. A review of the application history confirms that a period of adjustment of 4 days should not have been entered for Office delay in taking action in response to applicant's amendment after final filed July 21, 2003. In fact, the Office took action within 4 months mailing an advisory action on August 27, 2003.

More importantly, as the amendment filed July 21, 2003 was not in compliance with § 1.113(c)¹, the period for reply to the final rejection mailed May 21, 2003, continued to run. A proper amendment was not received in the Office until November 12, 2003. (An amendment filed September 12, 2003 was non-compliant). Accordingly, pursuant to § 1.704(b), the patent term adjustment should have been further reduced by 83 days for applicant delay from August 22, 2003 to November 12, 2003 in filing a proper reply to the final rejection.

To the extent that this letter was submitted as an advisement to the Office of an error in Patentees' favor, the Office will not assess the \$200.00 application fee under 37 CFR 1.705(b). The Office thanks patentee for their good faith and candor in bringing this to the attention of the Office.

**Patentee's dispute of the patent term adjustment
at the time of the mailing of the notice of allowance**

In regards to the reduction of 27 days for the filing of an IDS on March 31, 2003, this request for reconsideration is untimely. Pursuant to 35 U.S.C. 154(b)(3)(B) and implementing regulation 37 C.F.R. § 1.705, an applicant shall receive an initial determination of patent term adjustment with the mailing of the Notice of Allowance and shall be given one opportunity to request reconsideration of that determination by way of filing of an application for patent term adjustment prior to the payment of the issue fee.

On November 25, 2003, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 179 days. This initial determination of patent term adjustment included calculation of the reduction of 27 days. PALM records indicate that the issue fee payment was received in the Office on February 6, 2004. No filing of an application for patent term adjustment preceded the payment of the issue fee. The period for filing an application for patent term adjustment requesting reconsideration of the initial determination of patent term adjustment at the time of mailing of the notice of allowance ended February 6, 2004. Accordingly, to the extent the instant application requests reconsideration of the 27 day reduction, it is appropriate to dismiss this petition as untimely filed.

¹ See Advisory Action mailed August 27, 2003.

**Patentee's dispute of the
revised patent term adjustment indicated in the patent**

In regards to the reduction of 58 days for the filing after the mailing of the notice of allowance of a Statement of Substance of Interview on December 10, 2003, patentee is advised that 37 CFR § 1.705(d) provides the avenue before the Office for requesting reconsideration of the patent term adjustment indicated on the patent based on a dispute of the Office's calculation of the patent term adjustment. Moreover, § 1.705(d) states that "any request for reconsideration of the patent term adjustment indicated in the patent must be filed within thirty days of the date the patent issued and must comply with the requirements of paragraphs (b)(1) and (b)(2) of this section." As the instant request for review of the patent term adjustment was filed within thirty days of the issue date of the patent, the request may be treated as timely filed under § 1.705(d). However, patentee did not submit the required fee under § 1.18(e).

If patentee wishes the Office to consider the request for correction of PTA under the provisions of 37 C.F.R. § 1.705(d), patentee must so advise the Office and clearly authorize payment of the required fee within the time period for response set forth in this decision.

CONCLUSION

In view thereof, the patent should have issued with a revised patent term adjustment of 0 days.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **ZERO (0)** days.

Telephone inquiries specific to this decision should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

*Karin Ferriter
frc*

Karin Ferriter
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Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of DRAFT Certificate of Correction